

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
	:	
Dennis KING	:	Confirmation Number: 2350
	:	
Application No.: 09/407,141	:	Group Art Unit: 2626
	:	
Filed: September 28, 1999	:	Examiner: L. Spooner
	:	
For: REUSABLE CONTROLS FOR AUTOMATICALLY TRANSLATING TEXT BETWEEN LANGUAGES		

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests that a Panel Review of the rejected claims in the Final Office Action dated August 24, 2006, be performed in the above identified application.

CLAIMS 1-5, 7, 9-13, 17-21, AND 23 ARE REJECTED UNDER THE FIRST PARAGRAPH ON

35 U.S.C. § 112

In the Amendment filed February 28, 2005, Applicant amended independent claim 1 to include the limitations previously presented in claim 6, claims 7, 15, and 23 were amended to be placed in independent form, claim 9 was amended to include the limitations previously presented in claim 14, and claim 17 was amended to include the limitations previously presented in claim 22. In this regard, Applicant notes that presently pending independent claims 1, 7, 9, 15, 17, and 23 are all directed to subject matter that was found in the original claims.

On page 3 of the Final Office Action, the Examiner rejected claims 1, 7, 9, 15, 17, and 23, asserting that the terms "wherein said text is an input field" and "wherein said text is an output field" is not enabled, nor described anywhere in the disclosure in a way that enables an artisan to make or use this limitation.

In response to Applicant's previously presented arguments in the Amendment filed May 5, 2006, in which Applicant argued that these limitations were enabled by Applicant's originally-filed disclosure, on page 2 of the Final Office Action, the Examiner disagreed and asserted the following:

Despite Applicant's arguments on page 7, of applicant's remarks, the Examiner is unable to find any teaching in applicant's cited sections or in the disclosure wherein, for example, for "text in the control", the "text is an input field.", claims 1, 7, and 9, and in claims 7, 15, and 23, for "text in the control", "wherein said text is an output field."

Reference is made to page 3, lines 6-7 of Applicant's disclosure, which is reproduced immediately below:

Additionally, the text may be found in an input field, an output field, or an object which has no visual representation.

Thus, Applicant respectfully submits that Applicant's disclosure enables the limitations recited in claims 1, 7, 9, 15, 17, and 23.

Notwithstanding that Applicant's specification provides support for this claimed terms, the Examiner must consider not only the original disclosure contained in the summary and detailed description of the specification, but also the original claims.¹ In the unpublished opinion of Ex parte Porter², the Board of Patent Appeals and Interferences recognized that subject matter

¹ In re Mott, 539 F.2d 1291, 1299, 190 USPQ 536, 542-43 (CCPA 1976); In re Anderson, 471 F.2d 1237, 1240, 176 USPQ 331, 333 (CCPA 1973).

² Appeal No. 1992-1668.

Application No.: 09/407,141

found in an original claim also finds descriptive support from the original claim. Specifically, the Board wrote:

As to the number of openings in the claimed nozzle, we note that such recitations of the number of nozzle openings were present in original claims 2 and 3. Since original claims constitute part of the original disclosure, In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973), the examiner's rejection of claims 2 and 3 under 35 USC § 112, first paragraph, as lacking descriptive support is clear legal error.

Therefore, for the reasons stated above, Applicant submits that the Examiner has committed clear error in rejecting the claims under the first paragraph of 35 U.S.C. § 112.

Date: November 24, 2006

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

CUSTOMER NUMBER 46320